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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,778	07/24/2003	Yoshinari Morimoto	116571	8193
25944	7590	03/15/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER HUFFMAN, JULIAN D	
			ART UNIT 2853	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,778

Applicant(s)

MORIMOTO, YOSHINARI

Examiner

Julian D. Huffman

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12 and 15-22 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 10 is/are rejected.
- 7) ☒ Claim(s) 4, 7-9, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 January 2006 has been entered.

### ***Election/Restrictions***

2. Applicant's election with traverse of species 2 in the reply filed on 1 March 2006 is acknowledged. The traversal is on the ground(s) that search and examination of the entire application could be made without serious burden. This is found persuasive because the non-elected claims 11 and 12 were indicated as allowed in the previous rejection and therefore there is no burden *presently* to further examine these claims.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that claims presented in a continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5, 6 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (U.S. 6,454,390 B1).

With regards to claim 1, Takahashi et al. discloses an ink jet printer, comprising:

a printing unit having a carriage and a print head (fig. 5) in which a plurality of ink jet nozzles are arranged in plural columns (fig. 6b), the printing unit printing on a printing medium while reciprocating the print head by the carriage for go-printing and return-printing (column 39, lines 5-9);

a sensor (fig. 8) disposed on the carriage (column 20, lines 58-60) and having a light-emitting portion (31) for emitting light toward the printing medium and a light-receiving portion (32) for receiving reflected light from the printing medium;

a test pattern printing control unit (fig. 9, elements 100, 150) that causes the printing unit to print a test pattern in which vertical ruled lines are arranged with a prescribed pitch (fig. 37);

a plural patterns printing instructing unit that causes the printing unit to print a plurality of test patterns while changing a test pattern printing interval of the return-printing with respect to the go-printing in plural stages (controller 100, fig. 37, column 39, lines 5-9);

a best pattern detecting unit for scanning-in the printed test patterns with the sensor and for automatically selecting a best test pattern from the scanned-in test patterns (30); and

a best pattern printing instructing unit that causes the printing unit to print information indicating an image of the selected best test pattern on the printing medium (controller, column 41, lines 45-50).

With regards to claim 2, Takahashi et al. discloses that the best pattern printing instructing unit causes the printing unit to print the selected best test pattern on the printing medium at the test pattern printing interval that produces the selected best test pattern as information indicating the image of the selected best test pattern (column 41, lines 45-50).

With regards to claim 3, the best pattern printing instructing unit causes the printing unit to print information indicating a test pattern printing interval that produces the selected best test pattern as information indicating the image of the selected best test pattern (column 41, lines 45-50).

With regards to claim 5, the sensor detects at least one of a front end portion, a rear end portion, and a width portion of the printing medium (since sensor is mounted on carriage it may detect any portion of paper, further as sensor scans, it detects various portions of the paper).

With regards to claim 6, Takashi discloses:

a detection result judging unit for judging whether a detection made by the best pattern detecting unit is appropriate (controller 100, column 17, lines 14-32 and column 33, lines 28-36); and

a re-detection executing unit that causes the printing unit to print the plurality of test patterns again while changing a printing condition and causes the sensor to scan the printed test patterns again when the detection result judging unit judges that the detection made by the best pattern detecting unit is not appropriate (controller 100, column 33, lines 38-43 and column 33, lines 38-43).

With regards to claim 10, Takahashi et al. discloses an ink jet printer, comprising:

a printing unit having a carriage and a print head (fig. 5) in which a plurality of ink jet nozzles are arranged in plural columns (fig. 6b), the printing unit printing on a printing medium while reciprocating the print head by the carriage for go-printing and return-printing (column 39, lines 5-9);

a sensor (fig. 8) disposed on the carriage (column 20, lines 58-60) and having a light-emitting portion (31) for emitting light toward the printing medium and a light-receiving portion (32) for receiving reflection light;

a plural patterns printing instructing unit that causes the printing unit to print a plurality of test patterns in each of which vertical ruled lines are arranged with a prescribed pitch, while changing a test pattern printing interval of the return-printing with respect to the go-printing in plural stages (controller 100, fig. 37, column 39, lines 5-9);

a best pattern detecting unit for scanning-in the printed test patterns with the sensor and for automatically selecting a best test pattern from the scanned-in test patterns (30); and

a best pattern printing instructing unit that causes the printing unit to print information indicating an image of the selected best test pattern on the printing medium (controller, column 41, lines 45-50).

### ***Response to Arguments***

5. Applicant's arguments filed 17 January 2006 have been fully considered but they are not entirely persuasive.

Applicant's argument that Takahashi does not disclose printing of information indicating an image of a selected best test pattern is noted. However, the confirmation pattern printed is information indicating an image of a selected best test pattern.

Further, should applicant persist in this argument, it is noted that "Where the sole distinction set out in the claims over the prior art is in the printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed, it is only where the claims define either new features of structure or new relations of printed matter to structure, or both, which new features or new relations give rise to some new and useful function or effect or result that claims may be properly allowed, *Ex Parte Gwinn*."

Printing information indicating an image of a selected best test pattern is an operation that does not define new physical structure or a new relation of printed matter to physical structure; it is merely done to provide ease and convenience to an end user.

Thus, assuming arguendo that Takahashi does not disclose printing information indicating an image of a selected best test pattern, the claims are still unpatentable.

Applicant's comments regarding interpreting claims in light of the specification are noted, however, limitations from the specification are not to be read into the claims. The examiner maintains that since Takashi discloses printing a confirmation pattern using coarse and fine adjustment amounts obtained from a selected test pattern, Takashi prints information indicating an image of a selected best test pattern. One of ordinary skill in the art at the time of the invention could determine, from the printed confirmation pattern, the selected best test pattern. Thus, the confirmation pattern is printing information indicating an image of a selected best test pattern.

Applicant has cited certain advantages of the prior art which allegedly are not disclosed in Takahashi, however, these advantages are not brought out in the claims.

Applicant's argument regarding claim 19 is persuasive. Additionally, this argument is relevant to claim 13, which also contains the relevant claim limitations. Accordingly, claims 19 and 13, and dependent claims 20-22 and 14, recite allowable subject matter.

#### ***Allowable Subject Matter***

6. Claims 4, 7-9, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11, 12 and 15-22 are allowed.




***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 10:00a.m.-6:30p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julian D. Huffman  
Art Unit 2853  
8 March 2006